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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,651	02/29/2000	MASANORI KAMATA	P18896	2074
7055 7590 05/10/2007 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER POON, KING Y	
			ART UNIT	PAPER NUMBER
			2625	
			NOTIFICATION DATE	DELIVERY MODE
			05/10/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 09/514,651	Applicant(s) KAMATA, MASANORI	
	Examiner King Y. Poon	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-52 is/are pending in the application.
- 4a) Of the above claim(s) 37-43,45,46,51 and 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35,36,44,47-50,53 and 54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 February 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation "when the numerical value input by the panel exceeds the display capacity of the screen in the copy mode, switches from the copy mode to the facsimile mode" (and the relationship of new drawing(s) with respect to fig. 3 if applicant believes that elected species I is related to the invention of other non-elected species) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

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Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 35, 36, 44, 47-50, 53, 54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 35: The limitation "a controller which, when the copy mode is set and when the numerical value input by the panel exceeds the display capacity of the screen in the copy mode, switches from the copy mode to the facsimile mode" is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 44: The limitation "switching from the copy mode to the facsimile mode, when the input numerical value exceeds the display capacity of the

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screen in the copy mode" is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 36, 47-50, 53, 54: Claims 36, 47-50 are rejected under 35 U.S.C. 112, first paragraph because they depend on rejected claims 35, 44.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 35, 36, 44, 47-50, 53, 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsunai (US 5,357,350).

Regarding claims 35, 44, 53, 54: Matsunai teaches an image recording apparatus (fig. 1) having a copy mode (STP1, fig. 4) and a facsimile mode (STP7, fig. 4), the image recording apparatus comprising; a panel section (column 5, line 18) which has input keys (column 5, line 11) operable to input a numerical value corresponding to at least one of a number of copies (column 6, lines 66-67, column 7, lines 1-2) in the copy mode and a telephone number of a destination in the facsimile mode (column 7,

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lines 3-10); a display section (18e, fig. 2A, 2B, column 5, lines 19-21) which selectively displays (STP 8, fig. 4, STP 34, fig. 5) one of a screen for the copy mode and a screen for the facsimile mode, a display capacity of the screen in the copy mode being smaller than a display capacity of the screen in the facsimile mode (STP6, fig. 4); and a controller (PPC 2, column 6, lines 45-46) which, when the copy mode is set and when the numerical value input by the panel section exceeds the display capacity of the screen in the copy mode (STP7 fig. 4), switches from the copy mode to the facsimile mode.

Regarding claim 36: Matsunai teaches wherein the display capacity of the screen, when the input numerical value corresponding to the number of copies is displayed, is smaller than the display capacity of screen, when the input numerical value the screen, when the input numerical value corresponding to the telephone number of the destination is displayed (STP6, fig. 4).

Regarding claims 47, 48: Matsunai teaches wherein the controller is configured to switch to the facsimile mode in response to the numerical value exceeding the display capacity of the screen in the copy mode (STP 6, STP 7, fig. 4).

Regarding claims 49, 50: Matsunai teaches the display comprising a single display region (the region of 18e that is displaying 003500 of fig. 2B) having a display capacity that changes in accordance with one of the copy mode and facsimile mode (fig. 4).

Response to Arguments

6. Applicant's arguments filed 11/16/2006 have been fully considered but they are not persuasive.

With respect to applicant's argument that fig 2 and page 6 and page 7 has support a controller which, when the copy mode is set and when the numerical value input by the panel exceeds the display capacity of the screen in the copy mode, switches from the copy mode to the facsimile mode.

In reply: page 6, lines 20-27 state that " the mode switching determining section determines whether or not the number of digits in the input value exceeds a threshold value in order to determine whether or not to switch the mode." This page does not state clearly whether it is the number of digits in the input value exceeds a threshold to cause the switch from copy mode to the facsimile mode or the number of digits in the input value does not exceed a threshold to cause the switch from copy mode to the facsimile mode.

Nowhere in drawing and the specification actually teaches the mode was switched from copy mode to the facsimile mode when determined that the number of digits in the input value exceeds a threshold value.

The only flow chart that explain the detailed process of applicant's invention is presented in fig. 3 (see page 4, lines 15-20 states fig. 3 is a flowchart illustrating an operation of the image recording apparatus of this invention, the invention of fig. 1, 2 of this invention). User input digits exceeds a threshold value at S3 and was detected at S4, flow chart 3 and page 9, lines 13-20 clearly teaches the mode is stop to prevent copying and a user has to press a reset key to start it over.

Nowhere in flow chart 3 shows when the copy mode is set and when the numerical value input by the panel exceeds the display capacity of the screen in the copy mode, switches from the copy mode to the facsimile mode.

Actually fig. 3 shows that the copy mode is not allowed to switch to the facsimile mode when input number exceeds the threshold and the copy mode is switch to the facsimile mode only when the input number does not exceed the threshold (yes to S5).

With respect to applicant's argument that Matsunai does not teach when the numerical value input by the panel exceeds the display capacity of the screen in the copy mode, switches from the copy mode to the facsimile mode, has been considered.

In reply: Column 5, lines 2-20 clearly teaches display of a copy number, magnification number which is limited to 5, as disclosed in fig. 4, STP6-STP8. To the machine of Matsunai, the number 4 is a copy value and the machine would copy according to fig. 4. Fig. 4 controls the display capacity of the copy mode.

Page 7 lines 10-15, applicant's specification, teaches "the threshold value for input digits is set at two to allow only two digits to be displayed, even if an entry is made three times, only two digits are displayed." Page 7, lines 10-15 does not teach if an entry is made three times, only two digits are displayed and the mode is switched. Page 7, lines 15-27 teaches the function of the pause key used to retain a value entered by a user with respect to an entry is made three times, and the function of the pause key is clearly disclosed in fig. 3.

Fig. 3 clearly shows that the mode switching section 24 subsequently switches the mode from the copy mode to the facsimile mode (S8) after the pause key has been

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entered and not switches the mode from the copy mode to the facsimile mode when an entry is made three times.

Therefore, the examiner interprets the display capacity of the copy mode, is how many digits entered by a user that the display would show during a copy mode. The digits are limited to 4 according to fig. 4 of Matsunai.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 6, 2007

A handwritten signature in black ink, appearing to read 'K. Y. Poon', with a stylized flourish at the end.

KING Y. POON
PRIMARY EXAMINER